

Amendments to the Drawings

Please amend Figs. 1 and 3 by replacing the first and third sheets of drawings with the accompanying replacement sheets that include color photographs of Figs. 1 and 3.

REMARKS

Upon entry of the foregoing amendments, claims 1-21, 23-27, and 30-32 remain pending in this application. Claims 1, 12, and 27 are the only pending independent claims. Claims 1, 6, 12, 16, 21, and 23-27 have been amended, without prejudice, as explained below. Claims 22, 28, 29, and 33 have been cancelled, without prejudice.

Indication of Allowable Subject Matter

Applicant is pleased to note the indication at page 5 of the Office Action that claims 22, 29 and 33 contain allowable subject matter, and would be allowable if they were written in independent form including all of the elements of the base claim and any intervening claims. Applicant has amended: (a) claim 1 to incorporate the subject matter of claim 33, (b) claim 12 to incorporate the subject matter of claim 22, and (c) claim 27 to incorporate the subject matter of claim 29. Accordingly, all of the independent claims now should be in a condition for allowance. Since the independent claims should be allowable, Applicant respectfully submits that claims depending therefrom also should be patentable.

Explanation of the Amendments

The brief description of the drawings section of the specification has been amended as suggested by the Examiner to include a notification that at least one of the drawings is available in color. In addition, new color drawings for Figs. 1 and 3 have been submitted for clarity as recommended by the Examiner.

As explained above, claims 1, 12 and 27 have been amended to incorporate the subject matter of allowable claims 33, 22 and 29, respectively.

Claims 1, 12, 24, and 26 have been amended to use “the” instead of “said” for the sake of consistency.

Dependent claim 25 has been amended to specify “cervical root” to remain consistent with claim 12.

The dependency of each of claims 6 and 16 has been amended to depend from claims 5 and 15, respectively, to assure that the “fibroblast growth factor” in claims 6 and 16 has appropriate antecedent basis, since claims 4 and 14 did not refer to a “fibroblast growth factor.”

Claims 1, 12, 23, 25, and 27 have been amended to delete specific recitations of “the step of” or “the steps of,” since such recitations are unnecessary and may have resulted in such claims being interpreted as step plus function claims under 35 U.S.C. § 112, sixth paragraph, which is not intended.

Since no new matter has been added by any of the foregoing amendments, their entry is respectfully requested.

Objections

The drawings were objected to as being too dark and unclear. New color drawings for Figs. 1 and 3 have been submitted as suggested by the Examiner, along with an accompanying Petition to Accept Color Photographic Drawings (37 C.F.R. § 1.84(a)(2) and (b)(2)). Accordingly, reconsideration and withdrawal of the objection to the drawings are respectfully requested.

35 U.S.C. § 101

Claims 30, 31, and 32 were rejected for containing non-statutory subject matter for allegedly being directed to human anatomy. However, these claims do not claim human anatomy. They refer to human anatomy, since the methods are methods to treat humans, but they do not claim the anatomy itself. Dependent claims 30, 31, and 32 merely describe the specific nerves on which the invention may be used. Many thousands of U.S. patents have been issued relating to methods for treating humans. As an illustration of one patented invention making reference to human anatomy, but not claiming the anatomy itself, please see Cheng *et al.* U.S. Patent No. 6,808,530 (a division of Cheng *et al.* U.S. Patent No. 6,235,041 (“Cheng ’041”)) that was cited in the Notice of References Cited (Form PTO-892) accompanying the Office Action (“1. A method for restoring a deficiency in the spinal cord of humans comprising the step of bridging spinal cord gaps with multiple intercostal nerve grafts redirecting specific pathways from white to gray matter.”). Therefore, reconsideration and withdrawal of the rejection based on non-statutory subject matter are respectfully requested.

35 U.S.C. § 102(b)

Claims 1-21 and 23-27 were rejected under 35 U.S.C. § 102(b) as anticipated by Cheng '041. In view of the amendments to claims 1, 12, and 27, the rejection of these claims, and claims 2-11, 13-21, and 23-26 that depend from these independent claims, is believed to be overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

Claims 10, 11, 20, and 21 were rejected as being anticipated by Cheng '041 in view of the alleged structural limitations recited in the claims. It appears the Examiner misunderstood the elements of claims 10, 11, 20 and 21, since these claims do not relate to structural limitations, but rather recite ingredient components in a composition used in a method, which would affect the claimed method. In any event, these are dependent claims that ultimately depend from allowable independent claims, and therefore, should be patentable themselves. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

By overcoming all of the objections and rejections set forth in the Office Action, Applicant believes that the present application is now in condition for allowance. Reconsideration and withdrawal of all objections and rejections and an early Notice of Allowance are respectfully solicited.

The Examiner is invited to contact the undersigned attorney by telephone to advance the prosecution of this application in the event that any issues are still considered to be outstanding.

Respectfully submitted,

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(Date)

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